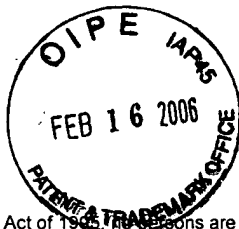


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5725.0639-00

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Signature _____

Typed or printed name _____

Application Number

09/931,919

Filed

August 20, 2001

First Named Inventor

David W. CANNELL

Art Unit

1616

Examiner

QAZI, Sabiha Naim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 56,821☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


SignatureCourtney B. Meeker

Typed or printed name

202-408-4496

Telephone number

February 16, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of ____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
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Attorney Docket No. 5725.0639-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
David W. CANNELL et al.) Group Art Unit: 1616
)
Application No.: 09/931,919) Examiner: Qazi, Sabiha Naim
)
Filed: August 20, 2001) Confirmation No.: 4335
)
For: METHODS FOR RELAXING AND)
RE-WAVING HAIR COMPRISING)
AT LEAST ONE REDUCING)
AGENT AND AT LEAST ONE)
HYDROXIDE COMPOUND)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the non-final Office Action dated November 16, 2005, wherein claims 1-9, 12-30, and 33-40 have been twice rejected, and further to the Notice of Appeal filed herewith, Applicants respectfully request review of the outstanding rejections.

Claims 1-9, 12-30, and 33-41 have been rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,572,843 ("Sorenson") and over U.S. Patent No. 4,659,566 ("Petrov"). Applicants respectfully submit that each of these rejections is legally improper and should be withdrawn because the Examiner has not established a *prima facie* case of obviousness.

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143. To meet this

burden, the Examiner must point to some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify the reference's teachings with a reasonable expectation of success. See M.P.E.P. §§ 2143.01 and 2143.02; *In re Fine*, 5 U.S.P.Q.2d 1596, 1598, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in Applicants' disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 947 F.2d 488 (Fed. Cir. 1991). Applicants submit that the Examiner has not met either of these criteria with respect to the proposed modifications of either Sorenson or Petrow.

First, the § 103 rejection over Sorenson is legally improper because Sorenson does not disclose specific steps of the present invention nor does the Examiner point to any motivation to arrive at the present invention and any reasonable expectation of success. The Examiner improperly bases her finding of obviousness on the assertion that Sorenson teaches the same method as the present application and they differ only in that the present invention "claim[s] more specific steps." See Office Action at p. 3. The Examiner merely points to disclosure of some of the individual steps of the present claims in Sorenson and has not revealed any motivation to arrive at the specific claimed method. See *id.*

Sorenson, however, does not disclose each of the specific steps of the method in the present claims, as set forth in claim 1, including the heating step, step (v). Not only does Sorenson fail to teach or suggest the heating step, it specifically notes that "[h]air setting processes . . . are usually carried out at room temperature," col. 1, lns. 22-24,

and none of the examples disclosed therein contain a heating step, col. 37, ln. 35 to col. 47, ln. 22. Additionally, nothing in Sorenson would suggest use of a heating step specifically after the application of the composition comprising generated hydroxide ions. If anything, one of ordinary skill in the art would "reasonably infer" from Sorenson that the method disclosed therein should occur at room temperature, not that it should include a heating step. The Examiner has not explicitly set forth sufficient evidence of a motivation to arrive at the combination of steps in the present claims based on the disclosure of Sorenson.

Furthermore, only in hindsight could it have been obvious to one with Sorenson before her to have arrived at the claimed method with any reasonable expectation of success, and such use of hindsight reconstruction is impermissible. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600, 837 F.2d 1071, 1075 (Fed. Cir. 1988). As stated above, Sorenson does not teach or suggest that the particular combination of steps, including the heating step, in the presently claimed method would relax keratin fibers. Accordingly, one of ordinary skill in the art would not have had the requisite reasonable expectation of success in the method of the present claims based on the teachings of Sorenson.

In the absence of "clear and particular evidence" of a motivation to combine the elements of the present claims and an expectation of success from such combination, the rejection should be withdrawn. In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Sorenson, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

The § 103 rejection over Petrow is also legally improper because Petrow does not disclose specific steps of the present invention nor does the Examiner point to any motivation to arrive at the present invention and any reasonable expectation of success. The Examiner improperly bases her finding of obviousness on the assertion that Petrow teaches the same method as the present application and they differ only in that the present invention "claim[s] more specific steps." See Office Action at p. 5. Again, the Examiner merely points to disclosure of some of the individual steps of the present claims in Petrow and has not revealed any motivation to arrive at the specific claimed method. See *id.*

Petrow does not disclose each of the specific steps of the method in the present claims, as set forth in claim 1, including the heating step, step (v). Petrow only discloses heating the fibers after application of the reducing agent composition, see *e.g.*, col. 16, Ins. 20-30, and does not teach or suggest heating of the fibers after application of a composition comprising generated hydroxide ions. Additionally, at col. 9, Ins. 50-55, Petrow teaches the application of the reducing agent at room temperature. Therefore, nothing in Petrow would suggest use of a heating step specifically after the application of the composition comprising generated hydroxide ions. The Examiner has not explicitly set forth sufficient evidence of a motivation to arrive at the combination of steps in the present claims based on the disclosure of Petrow.

Furthermore, only using impermissible hindsight could it have been obvious to one with Petrow before her to have arrived at the claimed method with any reasonable expectation of success. As stated above, Petrow does not teach or suggest that the particular combination of steps, including the heating step, in the presently claimed

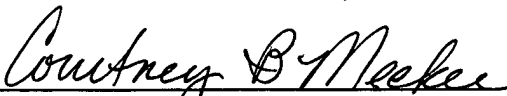
method would relax keratin fibers. Additionally, Petrow repeatedly teaches disadvantages of using thioglycolates, as in step (i) of the present invention. Petrow teaches that they are caustic, result in overprocessing, and have a disagreeable odor. See col. 2, Ins. 8-10, col. 3, Ins. 27-42. Accordingly, one of ordinary skill in the art would not have had the requisite reasonable expectation of success in the method of the present claims based on the teachings of Petrow.

In the absence of "clear and particular evidence" of a motivation to combine the elements of the present claims and an expectation of success from such combination, the rejection should be withdrawn. In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Petrow, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of all the rejections. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 16, 2006

By: 
Courtney B. Meeker
Reg. No. 56,821